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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,457	10/29/2001	Craig Stephen Slavtcheff	J6717(C)	1607

201 7590 06/23/2004

UNILEVER
PATENT DEPARTMENT
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EXAMINER

GHALI, ISIS A D

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,457

Applicant(s)

SLAVTCHEFF ET AL.

Examiner

Isis Ghali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/24/01, 2/15/02, 7/29/02, 10/01/02,</u>
<u>10/16/02, 4/7/03, 4/21/03</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

The receipt is acknowledged of IDS, filed 10/29/2001; IDS, filed 02/15/2002; IDS, filed 07/29/2002; IDS, filed 10/07/2002; IDS, filed 10/16/2002; IDS, filed 04/07/2003, and IDS, filed 04/21/2003.

Priority

1. If applicant desires priority under 35 U.S.C. 119(e) based upon a previously filed application, specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. ____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the

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application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/022,458. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims and the claims the copending applications are potentially conflicted. The claims of both of the applications are directed to product comprising adhesive strip and an imaging substrate and method of its use to evaluate the efficacy of a cosmetic that affect the texture of the skin as wrinkles.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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4. Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/370,855. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims and the claims the copending applications are potentially conflicted. The claims of both of the applications are directed to product comprising cosmetic composition and a test device, and method of its use to evaluate the efficacy of an anti-aging agent.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Specification

5. The use of the trademarks "DeSquame" and "Flexcon" have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: between step (B) after applying the cosmetic product and step (C) placing the adhesive surface of the strip against the skin treated with the cosmetic product. It is not defined in the claims or in the specification when the adhesive strip is placed? Is it right after the application of the cosmetic product and on top of it, or after elapsing of time of action of the cosmetic product to evaluate its effect? Clarification is requested.

Further, claim 15, recites “fixative device” that does not set out the metes and bounds of the claim. Recourse to the specification does not define the expression. Clarification is requested.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2284154 ('154).

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GB '154 disclosed an anti-aging composition and method for testing its effect on the skin by measuring the depth of the wrinkles and skin firmness by applying adhesive impression mixture uniformly on the test area, then removing it and read it by binocular magnifier (abstract; page 3, lines 22-25; page 4, lines 26-34; page 5, lines 1-2). The test evaluates the structural components of the micro-contour of the skin to evaluate the effect of the cosmetics (page 3, lines 26-30). The impressions are taken on treated skin before applying the cosmetic, and frequently after to test the efficacy of the cosmetic (page 4, lines 14-18, 35-38; page 5, lines 8-14). The adhesive used comprises an adhesive and liquid activator, which reads on fixative (page 3, lines 35-39). The package does not impart patentable weight with regard to 102 rejection absent functional relationship between the package and the product, and because the product still function equally effectively with or without the package.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB '154 in view of US 5,088,502 ('502).

The teachings of GB '154 are discussed under 102 rejection above. However, GB '154 does not teach the structure of the testing device or the type of the adhesive.

The type of the adhesive does not impart patentability to the claims, absent evidence to the contrary.

US '502 disclosed a device for sampling the surface of the skin including a substrate layer and an optically clear adhesive layer disposed on the substrate and covered by removable protective liner. The adhesive follows and conforms to the configuration of the surface of the skin under pressure, i.e. pressure sensitive adhesive that has sufficient tack to maintain an imprint of the skin (abstract; col.1, lines 41-48; col.2, lines 6-10). The nature of the skin surface is visualized by contrast against dark colored substrate (col.2, lines 3-34).). The device provides easy application with repeatable results for uniform testing of skin surface (col.2, lines 34-35).

Thus, it would have been obvious to one having ordinary skill in the art the time the invention was made to provide a method product for evaluating efficacy of anti-aging

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treatment on the skin surface by taking impressions on the treated skin before and repeatedly after treatment as disclosed by GB '154, and use adhesive device comprising strip and the dark imaging substrate to visualize the obtained texture as disclosed by US '502, motivated by the teaching of US '502 that the device provides easy application with repeatable results for uniform testing of skin surface, with reasonable expectation of having a method for testing the efficacy of anti-aging agent on the skin, wherein said method is easy and repeatable.

13. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over GB '154 in view of US '502 as applied to claims 1-5, 7-15 above, and further in view of US 6,270,783 ('783).

The teachings of GB '154 and US '502 are discussed above, however, the references in combination do not teach the claimed types of adhesive.

US '783 teaches a skin adhesive strip comprising a substrate and an adhesive layer with the most preferred adhesive is the acrylic polymer, starches as it provides the required tackiness to the skin (abstract; col.4, lines 38-43, 38-39, 57).

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide the product disclosed by GB 154 and US '502 combined, and select the acrylic adhesive polymer or starch, motivated by the teaching of US '783 that the acrylic adhesive is the most preferred as it provides the required tackiness to the skin, with reasonable expectation of having strip comprising an acrylic adhesive and substrate that provides the required tackiness to the skin of the user.

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14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. FR 2,063,743 discloses a process of diagnosis of skin types by applying an adhesive strip to provide accurate impression of the skin surface and getting imprints of wrinkles that are easy to see.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Isis Ghali
Examiner
Art Unit 1615

IG



ISIS GHALI
PATENT EXAMINER